



A35478 066123.0125

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tyagi et al.
Application No.: 10/687,402 Examiner: Fernandez, Susan
Filed: October 16, 2003 Art Unit: 1651
For: A SCREENING METHOD FOR DEVELOPING DRUGS AGAINST
PATHOGENIC MICROBES HAVING TWO-COMPONENT SYSTEM

RESPONSE TO RESTRICTION REQUIREMENT

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

December 6, 2004

Rochelle K. Seide
Attorney Name

Signature

32,300

PTO Registration No

December 6, 2004

Date of Signature

Commissioner for Patents
Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is being filed in response to the Office Communication dated November 5, 2004 that was issued in the above-identified application. Applicants submit that the present response is being timely filed on December 6, 2004, which is the Monday following the due date of December 5, 2004.

The Examiner has issued a restriction requirement and requires selection of one of three groups of claims for prosecution in this application. The Examiner has placed the pending claims into the following groups:

Group I: Claims 1-7, drawn to a screening method of inhibitors of pathogenic microbes having DevR-DevS and/or DevR-Rv2027c and its homologues;

Group II: Claims 8-16, drawn to a method of treating disease conditions caused by pathogenic microbes having DevR-DevS and/or DevR-Rv2027c or homologues; and

Group III: Claims 17-21, drawn to a composition useful in the control of disease conditions caused by pathogenic microbes having DevR-DevS and/or DevR-Rv2027c or homologues.

The Examiner alleges that the inventions are distinct. With regard to Groups I and II, the Examiner alleges that the methods are distinct physically and functionally and are not required for one another. The Examiner also alleges that a search and examination of both would result in an undue burden. With regard to Groups III and I, the Examiner alleges that the compositions of Group III are neither made by or used in the methods of Group I and each does not require the other. With regard to Groups II and III, the Examiner alleges that they are related as product and process of use. The Examiner alleges that the compositions of Group III can be used for processes that are materially different from the method of Group II. The Examiner further alleges that the restriction is proper for their divergent subject matter and different classifications.

Applicants respectfully traverse. The requirement for a restriction between patentably distinct inventions is proper when: (a) the inventions are independent or distinct and

(b) there is a serious burden on the examiner. M.P.E.P. § 803. Both of these requirements must be met for the restriction requirement to be warranted.

Applicants submit that the inventions of Groups I, II, and III are not distinct. The inventions are connected in that all relate to the use of pathogenic microbes having DevR-DevS and/or DevR2027c mediated signal transduction.

It is also respectfully asserted that the field of search for the three groups would not be different from one another. The search for each of the three groups would involve the investigation of pathogenic microbes having DevR-DevS and/or DevR2027c or homologues thereof. The claims of Groups I, II, and III are connected by a single, searchable unifying relationship. Applicants also point out to the Examiner that Groups II and III have been placed in the same class, 514. They do not have a separate status forming a separate subject for inventive effort, and a search would not require a different field of research. As such, there would not be a "serious" burden on the Examiner to examine all the claims of the present application together.

For the foregoing reasons, Applicants respectfully request withdrawal of the restriction requirement.

In the event that the Examiner is not persuaded by the arguments presented above, Applicants provisionally elect Group I, i.e., claims 1-7. This election is made with traverse, and without prejudice to the prosecution of the subject matter of non-elected claims and subject matter in other patent applications.

The Examiner has also imposed a species election. The Examiner alleges that the claims are directed to the patentably distinct species as follows:

(a) the DevS derivatives recited in claim 2;

PATENT

(b) the Rv2027 derivatives recited in claim 3; and

(c) the DevR derivatives recited in claim 4.

Applicants elect DevS₅₇₈ of (a), Rv2027₁₉₄ of (b), and DevRN₁₄₅ of (c), with traverse. Claim 1 is generic and are readable thereon. Upon determination that the elected specie are allowable subject matter, Applicant is entitled to consideration of further species in this application.

Applicants believe that there is no fee required with the submission of this paper. However, should any fee be required or overpayment made in connection with this submission, they may be charged to Deposit Account No. 02-4377. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

BAKER BOTTS L.L.P.

By: 

Rochelle K. Seide

Patent Office Reg. No. 32,300

Attorney for Applicants

30 Rockefeller Plaza

44th Floor

New York, NY 10112

(212) 408-2500